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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/778,023 | 02/05/2001 | Stacy S. Cook | | 6223 |

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| EXAMINER |
|---|
| RUTLEDGE, DELLA J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2851 | |

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

P.5

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/778,023 | COOK ET AL. | |
| | Examiner | Art Unit | |
| | D. Rutledge | 2851 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-95* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-95* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

**DETAILED ACTION**

***Information Disclosure Statement***

**DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement filed September 10, 2001 has been placed in the application, but will not be considered by the examiner.

The Statement consists of five boxes of prior art, which is made up of 145 references.

No discussion of relevance was provided.

Rule 37 C.F.R. 1.56(a) sets forth the requirements for duty of disclosure and states that the applicant has:

> "a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be **material to patentability** (emphasis added)"

The Rule, then, goes to state:

> "There is not duty to submit information which is not material to the patentability of any existing claim".

Rule 37 C.F.R. 1.56(b) clarifies what is intended by material to patentability and states:

> "Under this section, information is material to patentability when it is not cumlative to information already of record or being made of record in the application, and
>
> 1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim."

As is clear from the rule, applicant's duty of disclosure is intended to allow submission of relevant prior art which is believed to be material to the patentability of the claim(s) and which establishes a *prima facie* case of unpatentability of that claim. The intent of the rule was not to allow for submission of every patent in an art area irregardless of whether such is relevant to the claimed invention, or not. Clarification of the intent of the rule is set forth in MPEP section 2001.05 where it states "information is not material unless it comes within the definition of 37 CFR 1.15(b)(1) or (2). If information is not material, there is no duty to disclose the information to the Office." Further clarification is set forth in MPEP section 2004, entitled "Aids to Compliance With Duty of Disclosure", item thirteen (13), which states that "It is desirable to avoid the submission of long list of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be most significance.".

In the present application the submission does not comply with the intent of 37 CFR 1.56 by submitting one hundred forty-five references with no discussion of relevance to the claims, and such submission goes against the public policy for which the Rule was written. By submitting such a large volume of prior art, it is apparent that the applicant has not tried to eliminate any irrelevant and cumulative information. The applicant has also failed to identify in any manner any piece of art which might be relevant, and since there was no discussion of the relevance presented with the documents, the submission of such a large volume of documents is of no assistance. Applicant's submission would

be the equivalent of looking for a needle in a haystack to find anything that might be useful.

The court has recognized the irrelevance of submissions similar to that in this application, and has stated:

> "Significantly, an applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "a mountain of largely irrelevant [material] from which he is *presumed* to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work." *Rohm & Haas Co. v. Crystal Chemical Co.* 722 F.2nd 1556,1573 [220 USPQ 289], (Fed. Cir., 1983)".

As delineated above, the submission does not comply with 37 CFR 1.56 and therefore has not been considered by the examiner.

Summary: Consideration of the Information Disclosure Statement filed September 10, 2001 is denied.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1 – 24, 26 – 45, 47 – 63, 65 – 95 are rejected under 35 U.S.C. 102(e) as being anticipated by Manico et al. (US 6,174,094).

Manico et al. disclose a self-service film processing device, kiosk, that develops, scans and digitizes images. The device discloses that any payment means may be used including currency and credit cards. The images may be printed at the kiosk or printed remotely. The reference discloses using digital printing, which would include ink jet and sublimation printing. A customer receipt is printed. The customer may choose the image to print using a touch screen. The memory means comprises a CD, flash card, etc. The images may be given to the customer or transmitted to a remote location or over the Internet.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 35 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al. (US 6,174,094) alone or in view of Dellert et al. (US 6,283,646). Manico et al. reference allows the customer to choose images and modifications to the images, therefore, choosing enhanced or un-enhanced images would be inherent. In any case, having such an option is known. Dellert et al., in column 11, lines 51-65, discloses allowing the customer to choose enhanced or un-enhanced images. One of ordinary skill in the art would adapt the use of this option, if it is not inherent, because it gives the customer more control over the quality and features that may desired in the images.

7. Claims 25, 46, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al. (US 6,174,094) alone or in view of Bell et al. (US 6,147,742). Manico et al. do not specifically mention the use of DVD, however, one of ordinary skill in the art would be able to adapt new storage devices to the basic teaching without resorting to an inventive step. Bell et al. have a photofinishing system which include self-service film processing devices and uses DVDs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Rutledge whose telephone number is (703) 308-1697. The examiner can normally be reached on Mon - Thurs, 6:00 AM - 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

305-3431 for regular communications and (703) 308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

D. Rutledge
Primary Examiner
Art Unit 2851

dr
November 16, 2001